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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/601,479 08/03/00 DUDLEY

D 5712-01-MJA

EXAMINER

HM22/0214

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RAI ASUBRAMANIAN, V

ART UNIT

PAPER NUMBER

1624

DATE MAILED:

02/14/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/601,479

Applicant(s)
Dudley et al.

Examiner
Venkataraman Balasubramanian

Group Art Unit
1624



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-30 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-30 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claims 1-30 are pending.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-13, drawn to compound of formula I where $F = N$ or $-NCH_2$ and X^1 , X^2 , X^3 and X^4 are carbons.

Group II, claim(s) 1-13, drawn to where $F = -CH_2N$ and X^1 , X^2 , X^3 and X^4 are carbons. .

Group III, claim(s) 1-13, drawn to compound of formula I other than those provided in Group I and Group II.

Group IV, claim(s) 14-30, drawn to various method of use of compound of formula I.

If Group III is elected applicants should elect a single F , X^1 , X^2 , X^3 and X^4 choices. Upon electing any one of the Group I-III, applicant may elect a specific method of use for a specific disease from group IV. If Group IV is elected, again, applicants should elect a specific method of use for a specific disease

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The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Where there is lack of unity the requirement for restriction is proper- See MPEP 803.02.

The requirement for unity of invention is two-fold: (1) common utility and (2) sharing a substantial structural feature disclosed as being essential to the utility.

Compounds of Group I, II and III are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack common core such as quinolinone vs naphthalenone vs various heteroaryl with upto 4 nitrogens fused quinolinone vs various heteroaryl with upto 4 nitrogens fused naphthalenone. Consequently, the groups have different classifications and require separate prior art searches. They can be made and used independently. Art which may render obvious or anticipate one of the groups would not necessarily do the same for the other group. For example Information Disclosure Statement shows several references (see Ritcher et al and others) which teach on some of the compounds of the instant invention. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Group I-III and IV are related as product and various method of use. As evidenced by the prior art cited in the Interantional Search Report, instant compound read on the prior art and the common utility requirement is not met with as prior art teach different utility for compounds taught. Furthermore, note MPEP 806.05 permits single use to be joined with product claim.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Due to distinct nature of each of the inventions, a restriction is set forth in writing. .

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Vb

V. Balasubramanian (Bala)

2/11/2001


JOHN M. FORD
PRIMARY EXAMINER
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